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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER D. FARNES, AMY SILVERMAN, STEPHEN P.
BEAR, DAVID J. WONG, and SUZANNE JONAS

Appeal 2009-002770
Application 10/085,652
Technology Center 3600

Decided: June 2, 2009

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
KEVIN F. TURNER *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 of the Final Rejections of claims 1-33. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART and enter NEW GROUNDS OF REJECTION UNDER 37 C.F.R. § 41.50(b).¹

THE INVENTION

Appellants' claimed invention relates to a method and system which provide a set of actions and tools to help identify and model customer experience requirements (Spec. p. 1, ll. 6-7).

Independent claim 1, which is deemed to be representative, reads as follows:

1. A method for developing a solution to a customer experience issue, said method comprising:
 - a) identifying a target customer including customer requirements and a customer profile;
 - b) defining a current customer experience and comparing it with a customer experience provided by a competitor;
 - c) summarizing values and benefits that should be provided to said target customer;
 - d) identifying metrics for measuring success of a solution;
 - e) identifying gaps between current solutions and said benefits; and
 - f) generating solutions for delivering said benefits and selecting a solution path which delivers the greatest number of benefits.

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jun. 08, 2007) and Reply Brief ("Reply Br.," filed Mar. 24, 2008), and the Examiner's Answer ("Ans.," mailed Jan. 23, 2008).

THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ulwick	6,115,691	Sep. 05, 2000
Bruce	2002/0049621 A1	Apr. 25, 2002

The following rejections are before us for review:

1. Claims 1, 2, 4, 13, 14, 18, 19, 27-30 and 33 are rejected under 35 U.S.C. §102(b) as being anticipated by Ulwick.
2. Claims 3, 5-12, 15-17, 20-26, 31 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ulwick in view of Bruce.

ISSUES

1) Have Appellants shown that the Examiner erred in establishing that Ulwick teaches or suggests "a customer profile," a customer experience provided by a competitor, and identifying gaps between current solutions and said benefits as recited by Claim 1?

2) Have Appellants shown that the Examiner erred in establishing that Ulwick teaches or suggests identifying gaps between current solutions and benefits that should be provided to a target customer, defining a future customer experience for a selected solution, developing an architecture for implementing said solution path, and defining use-cases describing task interactions between participants in said solution path and said solution path as recited by Claim 27?

3) Have Appellants shown that the Examiner erred in establishing that Ulwick and Bruce teach or suggest identifying attributes of said target customer associated with said customer experience issue to generate a customer profile, generating a customer experience flow by organizing components of a current customer experience according to their order of occurrence, wherein said customer experience flow identifies instances in which customer requirements are unmet as recited by Claim 20?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1) Ulwick is directed to a system that uses customer related data to enable individuals and businesses to evolve and optimize their decision making ability by taking into account substantially all relevant variables and concerns that can affect a decision. (col. 5, ll. 46-52).

2) Ulwick refers to a mission "...as a particular task, project, or decision which an individual, employee, or business is contemplating. Upon selection of a specific mission, the data, including statements that define the criteria for creating value are retrieved from a database along with other pertinent facts that are critical to objective decision making." (col. 1, ll. 31-37).

3) Ulwick allows "...for each mission that a user may select, all the individuals, groups of individuals or customers that must be considered in order to achieve that mission are identified in advance, and presented to the user." (col. 6, ll. 7-10).

4) Ulwick uses predictive metrics to quantify whether an organization can compete effectively against other organizations as either strong, moderate, or weak. (Fig. 19a).

5) Ulwick discloses, “[t]he user is presented with a means by which to quantify the potential value of each alternative solution. This quantitative value is tied to statistically valid market research which is stored in one or more databases The solutions can be evaluated against each other or some other baseline for comparison. The baseline can be changed by the user at any time. Hundreds of comparisons can be made. The user can use this data to reach conclusions and gain a consensus on the value that a potential solution may deliver.” (col. 7, ll. 63-67 and col. 8, ll. 1-9).

6) Appellants’ Specification discloses, “In step A.7.7 of the present embodiment, a baseline is established by measuring the success criteria against the current solution, the value propositions, or the competitive solution. The baseline can be used to determine the best goal for each measure.” (Spec. p. 17, ll. 35-36 and p. 18, ll. 1-2).

6) Ulwick discloses, “Since the value of a potential solution can be determined in advance of its actual development or implementation, the user saves much time, effort, and money.” (col. 8, ll. 27-30).

7) The Specification does not provide a definition for “architecture.”

8) The ordinary and customary meaning of “architecture” is “4) [t]he organizational structure of a system or a software item, identifying its components, their interfaces, and a concept of execution among them.” (See *The Authoritative Dictionary of IEEE Standards Terms* (7th Ed. 2000)).

9) Ulwick discloses that “[t]he software of the present invention for implementing the process for strategy evaluation and optimization has been designed and implemented on a personal computer system, however, other computer systems can also be used to implement the process.” (col. 13, ll. 14-17).

10) Appellants’ Specification is silent as to what the scope of the “greatest number of benefits” comprises. We interpret this limitation to include all the possible desired outcomes and their results.

11) Ulwick discloses wherein the computer program is delivered to the user having desired outcome and predictive metric data pre-loaded. (col. 13, ll. 56-57).

12) Appellants’ Specification describes “use-cases” as, “the specific interactions the solution will need to support. First, the people (“actors”) who are likely to interact with the solution are identified, and the actors are then prioritized according to how important their interaction will be to the success of the solution. Next, the goals and tasks are identified for each actor.” (Spec. p. 25, ll. 1-7).

13) Appellants’ Specification describes “task interactions” as, “a sequence of numbered steps performed between the actor and the solution.” (Spec. p. 25, ll. 13-14).

14) Ulwick discloses when planning a phase of a project, intermediary steps such as production and delivery are analyzed so that the solution will be free from production or delivery issues. Ulwick also discloses that the “desired outcomes obtained are prioritized from importance by

representatives of the production or delivery organization.” (col. 15, ll. 51-61).

15) Ulwick discloses

The market may be segmented by what different customers value. Using customer desired outcomes as the basis for segmentation enables an organization to assess market opportunity with precision, and design products and services that address unique market needs. The results of the segmentation analysis often reveal the existence of segments that cut across traditional classification schemes. Each of these segments represents a new market opportunity.

(col. 14, l. 67 and col. 15, ll. 1-8).

16) Ulwick defines a desired outcome as, “a benefit of value to a particular customer. It is what the customer requires to obtain satisfaction. It is a statement that defines what the customer wants, why they want it, and how they perceive its satisfaction.” (col. 9, ll. 55-59).

17) Ulwick discloses that, “[t]he user is guided toward solutions that overcome specific weaknesses and allows them to integrate and combine the positive elements of that solution into an optimal solution.” (col. 8, ll. 10-15).

18) Ulwick uses predictive metrics that predict a desired outcome will occur. (col. 16, ll. 20-23).

19) Bruce is directed towards a method for analyzing business organizations using metrics where the processes can be defined by process flows to achieve the desired goals of the business organization ([0002]).

20) Bruce uses a benchmark or best practices analysis as a comparison tool to compare related information of two different projects. ([0465]).

21) Bruce discloses, “[a]nytime during the performance of the jobs the data sets for each job can be compared and used as a benchmark against each other. The comparison of the data sets can show which of the jobs performed is the actual best practice or most efficient in terms of time and resources consumed. ([0465]).

22) Bruce discloses, “the data collected is organized into categories of data based upon the type of data being collected. For example, one category of data relates to the risks/opportunities inherent in a particular job.” ([0466]).

23) Bruce discloses, “Opportunity data to be collected could be information on potential sales, potential discovery of new resources, or the lowering of a defect product rate during manufacturing.” ([0468]).

PRINCIPLES OF LAW

We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written description into the

claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enter., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment”). The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *see also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls”).

In KSR, the Supreme Court held that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does

no more than yield predictable results.” *KSR*, 550 U.S. at 416. The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417.

The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *See Oetiker*, 977 F.2d at 1445; *see also In re Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *see also In re Piasecki*, 745 F.2d at 1472.

ANALYSIS

ISSUE 1

Appellants argue claims 1-19 as a group.² We treat claim 1 as representative. *See 37 C.F.R. § 41.37(c)(1)(vii).*

The rejection of claims 1, 2, 4, 13, 14, 18, 19, 27-30 and 33 under 35 U.S.C. §102(b) over Ulwick.

Claim 1

Appellants argue that Ulwick does not teach or suggest identifying a target customer including customer requirements and a customer profile. (App. Br., p. 12). We are not persuaded by Appellants' argument and we agree with the Examiner's finding that Ulwick teaches the step of identifying a target customer including customer requirements and a customer profile. (FF 3). For each project, Ulwick presents to its users all relevant variables and concerns that can affect a decision along with other pertinent facts that are critical to objective decision making. (FF 1, 2). We interpret all relevant variables and concerns which can affect a decision to include customer requirements and customer profiles since this data would be used in order to complete the project. Accordingly, we find this argument unpersuasive.

Appellants next argue that Ulwick does not teach or suggest a customer experience provided by a competitor. (App. Br., p. 12). Specifically, Appellants argue that Ulwick "...make[s] no mention of a

² A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See 37 C.F.R. § 41.37(c)(1)(vii).*

‘competitor’ let alone a customer experience provided by a competitor.” (App. Br., p. 13). We agree.

The Examiner finds that Ulwick figure 19a shows a customer experience provided by a competitor. (Ans., p. 4). While Ulwick does indeed use predictive metrics to quantify whether an organization can compete effectively against other organizations as either strong, moderate, or weak, it does not teach a customer experience provided by a competitor. (FF 4). Therefore, we find the Examiner has erred in finding that Ulwick teaches or suggests a customer experience provided by a competitor. Accordingly, we do not sustain the Examiner’s rejections of claim 1 rejected under 35 U.S.C. § 102(b) as being anticipated by Ulwick.

Appellants further argue that Ulwick does not teach or suggest identifying gaps between current solutions and said benefits. Specifically, Appellants state that “Ulwick says nothing about ‘current solutions’ and therefore cannot teach or suggest ‘e) identifying gaps between current solutions and said benefits.’” (App. Br., p. 12). We are not persuaded by Appellants’ argument and we agree with the Examiner’s finding that Ulwick teaches the step of identifying gaps between current solutions and said benefits. (FF 5). Ulwick presents users with alternative solutions which are tied to market research. (FF 5). These alternative solutions can then be compared and the baseline for comparison can even be changed to identify any and all gaps. (FF 5). We interpret the baseline values to be the current solution which is compared against the alternative solutions. This interpretation is commensurate with Appellants’ Specification which also establishes a baseline by measuring the success criteria which we interpret as

alternative solutions against the current solution. (FF 6). Thus, by performing these steps, Ulwick performs the step of identifying gaps between current solutions and said benefits. Therefore, Appellants' argument is not persuasive as to error in the rejection.

Claims 2, 4, 13, 14, 18, and 19 dependent upon Claim 1

Appellants do not separately argue claims 2, 4, 13, 14, 18, and 19, depending from claim 1. Appellants sustained their burden of showing error in the rejection of claim 1 *supra*, and so has sustained its burden of showing that the Examiner erred in rejecting claims 2, 4, 13, 14, 18, and 19 under 35 U.S.C. § 102(b) as anticipated by Ulwick for the same reasons we found as to claim 1 *supra*.

ISSUE 2

Appellants argue claims 27-33 as a group.³ We treat claim 27 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 27

Appellants argue that Ulwick does not teach or suggest identifying gaps between current solutions and benefits that should be provided to a target customer. (App. Br., p. 14). We are not persuaded by Appellants' argument and we agree with the Examiner's finding that Ulwick teaches the step of identifying gaps between current solutions and said benefits. (FF 5). Ulwick presents users with alternative solutions which are tied to market

³ A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

research. (FF 5). These alternative solutions can then be compared and the baseline for comparison can even be changed to identify any and all gaps. (FF 5). With regard to the benefits that should be provided to a target customer, Ulwick allows the alternative solutions tied to market research to be compared. (FF 5). We interpret these alternative solutions to be the benefits which would be identified as gaps between the current solution and benefits that should be provided to the target customer. Thus, by performing these steps, Ulwick performs the step of identifying gaps between current solutions benefits that should be provided to a target customer. Therefore, Appellants' argument is not persuasive as to error in the rejection.

Appellants next argue that Ulwick does not teach or suggest the step of defining a future customer experience for a selected solution. Specifically, Appellants state that Ulwick, "say[s] nothing about 'a future customer experience,' let alone teach 'defining a future customer experience for a selected solution.'" (App. Br., p. 14). We are not persuaded by Appellants' argument and we agree with the Examiner's finding that Ulwick teaches the step of defining a future customer experience for a selected solution. (FF 6). Ulwick discloses that a potential solution can be determined in advance of its actual development or implementation. (FF 6). Although Ulwick does not explicitly state wherein the potential solution is a future customer experience, it would be implicit within the reference that the solutions identified and generated in Ulwick may be defined for a future customer experience for a selected solution. Therefore, Appellants' argument is not persuasive as to error in the rejection.

Appellants further argue that Ulwick does not teach or suggest developing an architecture for implementing said solution path. Specifically, Appellants state that, “[a]lthough Ulwick provides software that implements a process for evaluating and optimizing strategies Ulwick does not teach ‘d) developing an architecture for implementing said solution path’ where said solution path ‘delivers the greatest number of benefits’ as recited by Claim 27.” (App. Br., p. 15). Ulwick discloses wherein the process for strategy evaluation and optimization has been designed and implemented on a personal computer system. (FF 9). Since Appellants’ claim does not provide clear boundaries as to the scope of what an “architecture” comprises and the Specification provides no clear definition (FF 7), we construe the limitation according to its broadest reasonable interpretation as a software item. (FF 8). Thus, Ulwick discloses wherein the process is implemented by software. (FF 9). With regard to Appellants’ argument “where said solution path delivers the greatest number of benefits”, Appellants’ Specification is silent as to what the metes and bounds of this limitation comprises. (FF 10). Under the broadest reasonable interpretation, we interpret the limitation where solution path “delivers the greatest number of benefits” to include all the possible desired outcomes and results. (FF 10). Ulwick discloses wherein the computer program is delivered to the user having desired outcome and predictive metric data pre-loaded. (FF 11). Thus, Ulwick delivers all of the possible desired outcomes and results. Therefore, since Appellants’ have not provided their own lexicographic definition in the Specification for “architecture” and given the breadth of the claim, Ulwick teaches developing an architecture for

implementing said solution path. Accordingly, we find this argument unpersuasive.

Lastly, Appellants' argue that Ulwick does not teach or suggest defining use-cases describing task interactions between participants in said solution path and said solution path. In particular, Appellants state that Ulwick "say[s] nothing about 'use-cases' or 'task interactions,' let alone say anything about 'defining use-cases describing task interactions between participants in said solution path and said solution path.'" (App. Br., p. 15). We are not persuaded by Appellants' arguments and we agree with the Examiner's finding that Ulwick discloses the step of defining use-cases describing task interactions between participants in said solution path and said solution path (FF 14), albeit Ulwick says nothing about "use-cases" or "task interactions". However, consistent with Appellants' Specification, we interpret "use-cases" as the interactions the solution will need to support (FF 12) and "task interactions" as the steps necessary to achieve the solution. (FF 13). Thus, when planning a phase of a project, Ulwick defines and analyzes intermediary steps such as production and delivery so that the solution will be free from production or delivery issues. Therefore, when performing these steps, Ulwick defines the interactions the solution will need to support and the steps necessary to achieve the solution. (FF 14). Accordingly, Ulwick teaches defining use-cases describing task interactions between participants in said solution path and said solution path, and we find this argument unpersuasive.

Claims 28-30 and 33 dependent up on Claim 27

Appellants do not separately argue claims 28-30 and 33 depending from claim 27. Appellants have not sustained their burden of showing error in the rejection of claim 27 *supra*, and so have not sustained its burden of showing that the Examiner erred in rejecting claims 28-30 and 33 under 35 U.S.C. § 102(b) as anticipated by Ulwick for the same reasons we found as to claim 27 *supra*.

ISSUE 3

The rejection of claims 3, 5-12, 15-17, 20-26, 31 and 32 under 35 U.S.C. §103(a) over Ulwick and Bruce.

Claim 20

Appellants argue that that neither Ulwick nor Bruce, alone or in combination, teach or suggest, identifying attributes of said target customer associated with said customer experience issue to generate a customer profile. Specifically, Appellants' say that Ulwick "say[s] nothing about generating a customer profile let alone teach or suggest 'c) identifying attributes of said target customer associated with said customer experience issue to generate a customer profile.'" (App. Br., p. 18). We are not persuaded by Appellants' argument and we agree with the Examiner's finding that Ulwick teaches the step of identifying attributes of said target customer associated with said customer experience issue to generate a customer profile. (FF 15). For each project, Ulwick presents to its users all relevant variables and concerns that can affect a decision along with other pertinent facts that are critical to objective decision making. (FF 1, 2). We

interpret all relevant variables and concerns which can affect a decision to include attributes of said target customer associated with said customer experience issue. With regard to generating a customer profile, Ulwick uses customer desired outcomes as the basis for segmentation which enables an organization to assess market opportunity with precision, and design products and services that address unique market needs. (FF 15, 16). Thus, when analyzing customer desired outcomes to access market opportunity, the result of this analysis would generate a customer profile of the new target customer associated with this new market opportunity. (FF 15). Therefore, this segmentation would identify attributes of said target customer associated with said customer experience issue to generate a customer profile. (FF 15). Accordingly, we find this argument unpersuasive.

Additionally, Appellants argue that that neither Ulwick nor Bruce, alone or in combination, teach or suggest, generating a customer experience flow by organizing components of a current customer experience according to their order of occurrence, wherein said customer experience flow identifies instances in which customer requirements are unmet. (App. Br., p. 18). Ulwick guides users toward solutions that overcome specific weaknesses and allows them to integrate and combine the positive elements of that solution into an optimal solution. (FF 17). In performing this step, Ulwick identifies instances in which customer requirements are unmet by overcoming specific weaknesses. (FF 17). Since the desired outcomes in Ulwick are defined as what the customer requires to obtain satisfaction, a customer requirement which is not met would be considered to be a weakness. (FF 16). Thus, while guiding a user to an optimal solution,

Ulwick generates a customer experience flow by organizing components of a current customer experience according to their order of occurrence using predictive metrics. (FF 18). Therefore, Ulwick teaches generating a customer experience flow by organizing components of a current customer experience according to their order of occurrence, wherein said customer experience flow identifies instances in which customer requirements are unmet. Accordingly, we find this argument unpersuasive.

Claims 3, 5-12 and 15-17 dependent upon Claim 1

Appellants do not separately argue claims 3, 5-12 and 15-17 depending from claim 1. Appellants have sustained their burden of showing error in the rejection of claim 1 *supra*, and so have sustained its burden of showing that the Examiner erred in rejecting claims 3, 5-12 and 15-17 under 35 U.S.C. § 103(a) as unpatentable over Ulwick in view of Bruce for the same reasons we found as to claim 1 *supra*.

Claims 21-26 dependent upon Claim 20

Appellants do not separately argue claims 21-26 depending from claim 20. Appellants have not sustained their burden of showing error in the rejection of claim 20 *supra*, and so have not sustained its burden of showing that the Examiner erred in rejecting claims 21 -26 under 35 U.S.C. § 103(a) as unpatentable over Ulwick in view of Bruce for the same reasons we found as to claim 20 *supra*.

Claims 31 and 32 dependent upon Claim 27

Appellants do not separately argue claims 31 and 32 depending from claim 27. Appellants have not sustained their burden of showing error in the rejection of claim 27 *supra*, and so have not sustained its burden of showing that the Examiner erred in rejecting claims 31 and 32 under 35 U.S.C. § 103(a) as unpatentable over Ulwick in view of Bruce for the same reasons we found as to claim 27 *supra*.

CONCLUSION OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 2, 4, 13, 14, 18 and 19 under 35 U.S.C. § 102(b) as anticipated by Ulwick and claims 3, 5-12, 15-17 under 35 U.S.C. §103(a) over Ulwick and Bruce. We conclude that Appellants have not shown that the Examiner erred in rejecting claims 27-30 and 33 under 35 U.S.C. §102(b) over Ulwick. We conclude that Appellants have not shown that the Examiner erred in rejecting claims 20-26, 31 and 32 under 35 U.S.C. §103(a) over Ulwick and Bruce.

NEW GROUNDS OF REJECTION

The following new grounds of rejection are entered pursuant to 37 C.F.R. § 41.50(b).

Claims 1, 2, 4, 13, 18 and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ulwick in view of Bruce. Ulwick describes all of the limitations of claim 1 except for comparing a current customer experience with a customer experience provided by a competitor. However, Bruce

teaches a method for analyzing business organizations using metrics (FF 19) which compares related information of two different projects (FF 20) using data related to the risks and opportunities inherent in a particular project. (FF 21, 22). We find that one of ordinary skill in the art would have found the comparison of opportunity data such as potential sales data in Bruce to be analogous to the step of comparing a customer experience provided by a competitor. (FF 23) Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the comparison between the opportunity data of two different projects, disclosed in Bruce with the decision making system described in Ulwick in order to compare one company's current customer experience against its competition in an effort to develop a solution to a customer experience issue. Therefore, a person of ordinary skill in the art would have known from Bruce to compare the customer experience provided by a competitor and applied this technique to the current customer experience defined in Ulwick. (FF 3, 4).

Since none of the Examiner's findings regarding claims 2, 4, 13, 18 and 19 are in dispute, we adopt those Examiner's findings and apply them to the claims at issue.

We also reject claims 1-33 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. We take claim 1 as representative.

The issue is whether the process as claimed is patent eligible under 35 U.S.C. § 101. Claim 1 recites a method for developing a solution comprising identifying, defining, summarizing, and generating steps. The method claimed recites steps and is thus nominally drawn to a process. However,

the proper inquiry under § 101 is not whether the process claim recites sufficient "physical steps," but rather whether the claim meets the machine-or-transformation test.¹¹ As a result, even a claim that recites "physical steps" but neither recites a particular machine or apparatus, nor transforms any article into a different state or thing, is not drawn to patent-eligible subject matter. Conversely, a claim that purportedly lacks any "physical steps" but is still tied to a machine or achieves an eligible transformation passes muster under § 101.

In re Bilski, 545 F.3d 943, 961 (Fed. Cir. 2008) (*en banc*) (footnote omitted.)

Here, the claimed method is not tied to a machine nor does it transform a particular article into a different state or thing. Claim 1 does not recite a machine or apparatus. The method of claim 1 also does not transform a particular article into a different state or thing. Claim 1 does not transform any other particular article. We reach the same conclusion for the other method claims 2-33. Therefore, we reject claims 1-33 under 35 U.S.C. § 101 as being drawn to nonpatentable subject matter.

DECISION

The decision of the Examiner to reject claims 1, 2, 4, 13, 14, 18 and 19 under 35 U.S.C. § 102(b) as anticipated by Ulwick is not affirmed. The decision of the Examiner to reject claims 27-30 and 33 under 35 U.S.C. §102(b) over Ulwick is affirmed. The decision of the Examiner to reject claims 3, 5-12, 15-17, 20-26, 31 and 32 under 35 U.S.C. §103(a) over Ulwick and Bruce is affirmed. We enter new grounds of rejection of claims

1, 2, 4, 13, 18 and 19 under 35 U.S.C. § 103(a) as unpatentable over Ulwick in view of Bruce and claims 1-33 under § 101 under 37 C.F.R. §41.50(b).

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmation is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

41.50b

saw

Appeal 2009-002770
Application 10/085,652

cc:

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